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In the Supreme Court of the United States

ATLANTIC RICHFIELD COMPANY, ET AL., PETITIONERS

v.

UNION OIL COMPANY OF CALIFORNIA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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QUESTIONS PRESENTED

1. Whether there was sufficient evidence in the record to permit a jury to conclude that respondent's patent application satisfies the written description requirement of 35 U.S.C. 112.

2. Whether the courts below correctly construed the scope of respondent's patent for purposes of determining whether, under 35 U.S.C. 102, the patent's claims were anticipated by certain specialty aviation and racing fuels.

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This brief is submitted in response to the Court's order inviting the Solicitor General to file a brief expressing the views of the United States.

STATEMENT

Petitioners, a group of oil refiners, challenge the validity of United States Patent No. 5,288,393 (the '393 patent), owned by respondent. The '393 patent is directed to reformulated unleaded gasoline intended to reduce harmful automobile emissions. After the filing date of the '393 patent, but before the patent issued, the California Air Resources Board (CARB) set standards for gasoline that may be sold in California, which were formulated following detailed and joint consultations with various interested entities, including respondent. After CARB promulgated its standards, respondent amended its application to include 41 claims, some of which are similar to the CARB regulatory conditions.

After a jury trial, the district court entered judgment in favor of respondent. The Court of Appeals for the Federal Circuit affirmed, holding that the record

contained substantial evidence to support the jury's factual determinations and that the district court had correctly interpreted the scope of the patent claims.

1. Gasolines are derived from components that are refined from crude oil. Those components must be blended so that the resulting gasoline will have properties that will give satisfactory performance over an extremely wide range of operating and climatic conditions. C.A. App. 5952. The '393 patent has to do with producing gasolines with certain combinations of properties that will reduce automobile tailpipe emissions. Pet. App. 2a.

2. On December 13, 1990, respondent filed a patent application for what became the '393 patent. C.A. App. 447. The application asserted an invention date of March 1990.[1] At the time of the application, CARB had begun a process designed to lead to the establishment of requirements for reformulated gasolines that would reduce emissions in California. The process involved close consultation with interested parties, including refiners such as petitioners and respondent, who shared technical skills and data with CARB in an effort to arrive at standards that would achieve the maximum reduction in emissions at the lowest cost. Respondent was one of the firms that participated in the process.

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[1] During the same time period, respondent was involved in a joint research program sponsored by the automobile and oil industries to study how gasoline could be reformulated to reduce harmful emissions. Trial Tr. 1130-1137. The participants in the Auto/Oil program signed an agreement permitting each party to perform independent research and to protect any intellectual property assets that may arise from the individual research. *Ibid.* At the time the patent application was filed, CARB had already announced its intention to adopt reformulated gasoline regulations designed to reduce emissions, although the precise shape of those regulations was not yet clear. C.A. App. 5113-5131.

CARB announced its new regulations in November 1991, which were to be effective in early 1996. At that time, respondent was prosecuting the patent in the Patent Office. During the prosecution, respondent filed numerous information disclosure statements presenting information for consideration by the examiner, including one that informed the examiner of CARB's November 1991 standards. C.A. App. 5778-5782.

The '393 patent issued on February 22, 1994. Pet. App. 33a. The patent application contained 82 claims. *Id.* at 2a. During the prosecution of the patent, all of the patent's claims were modified. As issued, the patent included 155 claims, but respondent disclaimed all but the 41 at issue in this case. *Ibid.*

3. In April 1995, petitioners commenced this action in the district court against respondent for a declaratory judgment that the '393 patent was invalid. Respondent counterclaimed, alleging that petitioners were infringing the patent. Pet. App. 7a. After a 49-day trial and 13 days of deliberations, a jury reached a verdict in favor of respondent. *Id.* at 7a-8a. Two issues are of primary importance here.

a. First, 35 U.S.C. 112 provides that

> [t]he specification [in the patent application] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The "written description" component of that requirement must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*." *Vas-Cath Inc.* v. *Mahurkar*, 935 F.2d 1555, 1563-1564 (Fed. Cir. 1991).

Petitioners asserted that, because the claims of the '393 patent were substantially revised from those included in the original patent application, the patent application failed to supply a "written description" sufficient to show that respondent was in possession of the claimed invention as of the filing date of the patent application. Indeed, a primary argument of petitioners before this Court is that the claims of the '393 patent are derived from the 1991 CARB standards, rather than from the invention as described in the patent application in 1990. See, *e.g.*, Pet. 3, 14.

In a special verdict, the jury found that the written description requirement was satisfied by each of the 41 claims of the '393 patent. Pet. App. 8a. The trial court denied petitioners' post-trial motion for judgment as a matter of law on that point, finding "that substantial evidence exists in the record regarding the written description to support the verdict that [the inventors] had possession of the claimed subject matter." *Id.* at 54a.

b. Second, 35 U.S.C. 102(b) sets forth an "anticipation" requirement, which provides that a patent is valid unless "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent." Petitioners argued that the '393 patent was anticipated, because the compositions that it taught had in fact been used in aviation and racing fuels long before the '393 patent application was filed. The district court denied petitioners' summary judgment on that point, however, construing the claims of the patent to extend only to "unleaded gasoline fuels intended for regular use in automobiles, *i.e.*, traditional motor gasoline to be mass-produced at typical refineries for the general motoring public." Pet. App. 47a. The court held that, as so con-

strued, there remained a factual issue regarding "whether the patent merely reveals new properties of a previous invention * * * or whether it teaches a new process defined by the properties of the resulting composition." *Id.* at 46a. That issue was submitted to the jury, which found that none of the 41 claims was anticipated by prior art. *Id.* at 8a. The district court denied petitioners' post-trial motion for judgment as a matter of law on the anticipation issue. *Id.* at 51a-53a.

4. A divided panel of the court of appeals affirmed. Pet. App. 1a-31a.

a. With respect to the written description requirement, the court noted that that requirement "does not require the applicant to describe exactly the subject matter claimed" and that the "primary consideration is *factual* and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure." Pet. App. 13a. See also *id.* at 22a (referring to "the fact-sensitive nature of the written description inquiry"). The court stated that the '393 patent "teaches that changes in the proportions of different hydrocarbon-containing streams mixed to produce gasoline with specific properties reduces the amount of [emissions] from an automobile engine." *Id.* at 14a. Accordingly, "the patent claims its inventive products in terms of ranges of chemical properties, which work in combination with ranges of other chemical properties to produce a gasoline that reduces emissions." *Ibid.*

The court rejected the argument that "range" claims of the sort made by the '393 patent violate the written description requirement if they do "not describe the exact chemical component of each combination that falls within" the patent's claims. Pet. App. 15a. The court gave examples of the ways in which limitations in two

claims in the '393 patent were supported by the teachings recited in the patent's specifications. *Id.* at 16a-17a. The court also explained that the relevant question is "whether one of skill in the art could derive the claimed ranges from the parent's disclosure," not whether "the ranges in applicant's claims * * * correspond exactly to those disclosed in the parent application." *Id.* at 22a.

b. With respect to the anticipation argument, the court of appeals noted that the '393 patent "claims compositions of matter," and that "[t]he scope of these composition claims cannot * * * embrace only certain uses of that composition." Pet. App. 10a. The court examined the district court's construction of the patent, and it concluded that the district court "refus[ed] to narrow the scope of the claimed compositions to specific uses." *Ibid.* In particular, the court explained that the district court "construed the claims to cover only a narrow class of fuel compositions, namely only standard automotive gasoline," and that the court "correctly excluded from claim scope a broader class of petroleum formulations such as aviation fuels or racing fuels." *Ibid.*

The court of appeals found support for the district court's construction in the language used in the preamble to each of the claims, which refers to an "unleaded gasoline" and one that is "suitable for combustion in an automotive engine" or "in a spark ignition automotive engine." Pet. App. 10a. The court also noted that the specification described the problem addressed by the patent ("atmospheric pollution * * * caused by the emission of gaseous pollutants in the exhaust gases from automobiles") as one involving ordinary automobiles, and it noted that "ordinary passenger automobiles" had been used in the tests leading up to

the invention. *Id.* at 11a. Because "the '393 patent covers only standard automotive fuel," the court agreed with the district court (and found substantial support for the jury's conclusion) that "the aviation and racing fuels that allegedly invalidate the '393 claims do not anticipate because they do not contain each and every limitation of the claims." *Id.* at 12a. Indeed, even aside from the limitation to standard automotive fuels, the court concluded that "the record does not show that the aviation and racing fuels otherwise have the claimed characteristics of the particular standard automotive fuels recited in the '393 patent." *Ibid.*

c. Judge Lourie dissented from the majority's holding with respect to the written description requirement. Pet. App. 24a-31a. He did not address the anticipation issue. See *id.* at 24a.

Judge Lourie stated that the written description requirement requires "a precise description in the text of the patent specification of all of the aspects of the claimed invention." Pet. App. 25a. He agreed with the majority "that a patent need not describe the claimed subject matter in precisely the same terms as used in the claims," but "it must still describe the invention with all its claimed limitations in some manner." *Id.* at 26a. With respect to the '393 patent, Judge Lourie acknowledged that there "surely is a description of most of the particular *claim limitations* of the various claims," but he argued that "that is not the same as a description of a *specific composition* described by a particular selection of those characteristics." *Ibid.* Referring to the limitations of one of the '393 claims, Judge Lourie noted that "one can * * * find all of the limitations" in that claim in the specification, but "[w]hen one has to pick and choose among a wide range of variables to construct a claim, the subject matter of

that claim has not been described as required by the statute." *Id.* at 28a. In his view, therefore, the majority had "us[ed] enablement reasoning" to find that the patent application satisfied the distinct requirement that the specification adequately described the invention as ultimately claimed. *Id.* at 24a. He concluded that "[n]o reasonable jury, carefully reading and examining the patent specification, could conclude * * * that the patent specification's descriptions of individual fuel characteristics or the teachings that multiple fuel characteristics can be varied in particular ways constitutes a sufficient written description of the compositions of any of the claims." *Id.* at 31a.

DISCUSSION

Further review is not warranted. With respect to the written description requirement, the jury's conclusion that the patent application demonstrated that, prior to the CARB process, respondent was in possession of the invention that was ultimately claimed was highly dependent on the specific, and highly technical, facts of this case. With respect to the proper construction of the '393 patent, both lower courts agreed that, in light of the specific terms of the patent specification and claims, the patent should be construed not to cover specialty aviation and racing fuels that may otherwise have anticipated the claimed invention. In our view, although both of those issues present close questions, they involve only the meaning of the particular disclosures in the specifications of the '393 patent and the correct construction of that patent's claims. The ultimate importance of the '393 patent is not yet entirely clear. Even if it is as significant as petitioners fear, however, this Court's review is not warranted to address relatively narrow issues regarding the particular terms of a particular patent.

We share petitioners' and amici's concern about possible misuse of the regulatory process by a patent applicant. Moreover, it is important that protections afforded to competitors and to the public against inequitable conduct by patent holders be enforced. We do not believe, however, that the court of appeals decided any legal issue or altered settled legal principles in a way that would likely encourage misuse or inequitable conduct by patent holders in the future.

1. a. The written description requirement of 35 U.S.C. 112 is intended to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed. See, *e.g.*, *Vas-Cath Inc.* v. *Mahurkar*, 935 F.2d at 1563-1564; *In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976). It thereby guards against overreaching by the inventor, "by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation." *Rengo Co.* v. *Molins Mach. Co.*, 657 F.2d 535, 551 (3d Cir.) (quoted in *Vas-Cath*, 935 F.2d at 1561), cert. denied, 454 U.S. 1055 (1981). The written description requirement of Section 112 is distinct from the "enablement" requirement of the same Section, which requires the description to be sufficient to enable one skilled in the art to practice the invention. *Evans* v. *Eaton*, 20 U.S. (7 Wheat.) 356, 433-434 (1822) (decided under the Patent Act of 1793, ch. 11, 1 Stat. 318, which did not require presenting claims to an invention); see also *Universal Oil Products Co.* v. *Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944).

Both the majority and the dissenting opinions in the court below described the question whether a written description is sufficient as highly fact-specific. The majority referred to "the often cited rule that written description questions are intensely factual, and should

be dealt with on a case-by-case basis, without the application of wooden rules." Pet. App. 21a; see also *id.* at 22a ("Because of the fact-sensitive nature of the written description inquiry, this court has often warned against misapplication of precedents in this area."). The dissenting judge similarly noted the "case-by-case analysis" that must be applied to questions regarding the adequacy of the written description in a patent, and he acknowledged "that the written description requirement is a question of fact concerning which we owe considerable deference." *Id.* at 30a. See also *Vas-Cath*, 935 F.2d at 1562 ("The primary consideration is *factual*."); *In re Driscoll*, 562 F.2d 1245, 1250 (C.C.P.A. 1977) ("the precedential value of cases in this area is extremely limited"); *Wertheim*, 541 F.2d at 263 ("[b]roadly articulated rules are particularly inappropriate in this area"); *In re Smith*, 458 F.2d 1389, 1395 (C.C.P.A. 1972) ("Precisely how close the description must come to comply with § 112 must be left to case-by-case development.").

b. The substance of the written description issue turns on whether there was sufficient evidence supporting the jury's conclusion that the 41 claims of the '393 patent represent merely a narrowing of the originally claimed invention, as opposed to a new invention that would not be entitled to the filing date of the original application. Pet. App. 18a-21a.[2] The invention underlying the '393 patent is asserted to have been

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[2] Once a patent issues, it is presumed valid. 35 U.S.C. 282 (1994 & Supp. IV 1998), as amended by Patent Term Guarantee Act of 1999, Pub. L. No. 106-113, § 4402(b)(1), 113 Stat. 1501A-560. Accordingly, the burden is on the challenger (petitioners here) to prove invalidity by clear and convincing evidence. *Carella* v. *Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986).

predicated upon the discovery that there are a number of properties of gasoline that were previously thought to have affected performance, but that the '393 patent teaches have predictable effects on emissions as well. As the court explained, the "patent teaches one of ordinary skill" that reducing certain specific properties of gasoline progressively reduces carbon monoxide and hydrocarbons, while reducing other properties progressively reduces carbon monoxide and nitrogen oxides, "and so forth with several other relationships." *Id.* at 15a. The patent then "claims ranges for these properties that provide cleaner gasoline emissions." *Ibid.* Although the claimed ranges of properties do not inform refiners of the precise chemical makeup of the resulting gasoline mixtures, the court of appeals concluded that "the patentee in this case taught the desired characteristics of the final automotive fuels, realizing that those of skill in this art know that those characteristics define the claimed products." *Id.* at 20a-21a.

Petitioners argue that the written description was inadequate, however, because the 41 claims of the patent as issued differ from the claims in the original application. In particular, petitioners argue that respondent's application simply included "long lists of gasoline properties that in many respects simply corresponded to then-existing legal requirements" for gasoline, that the claims then were amended in a way that "resemble[d]" the CARB requirements, and that "[t]hose amendments contradicted the teachings of [respondent's] patent application." Pet. 15.[3] Of course,

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[3] Petitioners repeatedly quote the word "resemble" in arguing that respondent "participated with the rest of the oil industry in CARB's decision-making process, waited for CARB to make its regulatory decisions, and then scrapped all of the original claims

modification of the claims of a patent during prosecution is an accepted practice, for a variety of reasons. See, *e.g.*, 35 U.S.C. 132; 37 C.F.R. 1.111. As petitioners (and the dissenting judge) see it, however, the '393 application merely defined a large number of gasoline mixtures (a whole forest of "unmarked trees," in the commonly used metaphor adapted from *In re Ruschig*, 379 F.2d 990, 994-995 (C.C.P.A. 1967)), in the hope that some of them might turn out to be genuinely useful (*i.e.*, the "blaze marks" in the *Ruschig* metaphor that are a "help in finding one's way through the woods," *ibid.*). As it turned out the useful ones "resembled" those that emerged from the CARB process.

Regardless of which view is correct regarding the adequacy of the written description in the '393 patent, the issue does not warrant review by this Court. The Federal Circuit did not purport to eliminate or weaken the requirement that the written description in a patent application must describe the invention as ultimately embodied in the claims of the issued patent. Nor did it purport to hold that a laundry list of claimed combinations that do not point specifically to the claims of the issued patent would constitute a sufficient

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and substituted amended claims to 'resemble' the CARB regulations." Pet. 14; see also Pet. 2, 3, 4, 7, 15, 18. If, as the courts below held, respondent had a patentable invention at the time of the '393 patent application, the fact that respondent later narrowed the claims of that invention to focus on its most useful commercial applications would not render the '393 patent invalid. In any event, although petitioners do not provide the record citation for the term "resemble," a review of the passage on which they apparently rely indicates that it is ambiguous as to whether the claims were narrowed for the purpose of resembling the CARB regulations or whether they were narrowed in a way that simply had that effect. We have provided the relevant excerpt from the testimony in an Appendix to this Brief.

written description. The Federal Circuit's decision thus leaves in place the important safeguards in patent law that petitioners emphasize. See Pet. 16.[4]

In these circumstances, review by this Court would simply provide another opportunity to review the application of the settled legal principles, on which petitioners and the court of appeals largely agree, to the particular facts of this case. As noted above, the question whether a written description is sufficient is exceptionally closely tied to the particular circumstances of each case. Further review of that issue, therefore, is particularly unlikely to assist in developing generally applicable legal principles in this area. The '393 patent may well be an important one, although it is impossible to know with certainty the extent to which refiners will find ways to produce non-infringing reformulated gasoline that complies with the CARB—or other—standards.[5] But the validity of the '393 patent is not in

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[4] Petitioners state (Pet. 16) that the court of appeals' decision was an "evisceration of the long-standing doctrine under § 112 that stood as the only bulwark against gaming of the regulatory and patent regimes." We agree that Section 112 states important requirements that protect the public against patent monopolies that are unjustified by the purposes of patent law. We do not agree, however, that Section 112 is particularly directed toward "gaming of the regulatory and patent regimes," or that it is the "only bulwark" against such conduct. Other requirements of patent law, such as the requirement that the patentee himself be the inventor, see 35 U.S.C. 102(f), similarly serve to protect the public against such "gaming," as well as against other evils that would be attendant on unjustified grants of patent rights.

[5] On February 16, 1994, the Environmental Protection Agency published regulations for reformulated gasoline designed to reduce emissions in designated areas throughout the country, 40 C.F.R. 80.41, as well as regulations for determining compliance using an emissions model that calculates performance by looking at the levels of several components of gasoline. 40 C.F.R. 80.45. EPA

itself "an important federal question" that "has not been, but should be, settled by this Court." Sup. Ct. R. 10(c).[6]

2. For similar reasons, further review is not warranted with respect to the anticipation issue. As the parties recognize, that issue turns on the construction of the patent claims in this case. If the claims of the '393 patent apply to all fuels that are capable of being used in internal combustion engines, then they may well have been anticipated by the references to racing and aviation fuels that long predated the patent application here. On the other hand, if the claims of the '393 patent are limited to "a narrow class of fuel compositions, namely only standard automotive gasoline," Pet. App. 10a, then the references to racing and aviation fuels would not be invalidating.

The courts below relied on a number of features present in the patent application to find that the term "[a]n unleaded gasoline fuel suitable for combustion in an automotive engine" (or "in a spark ignition automotive engine"), Pet. App. 10a, point clearly to a composition of matter that is distinct from the kinds of compositions that are used in aviation or racing fuel. The district court recognized that "'suitable for combustion in an automotive engine' can be stretched to include any fuel

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developed its regulations after the CARB process had begun. Petitioners assert (Pet. 9) that respondent "will doubtless argue" that reformulated gasolines that comply with EPA's regulations "infringe[] [respondent's] patents" that followed the '393 patent.

[6] Amici States (Br. 3) state that respondent has obtained four patents similar to the '393 patent, and that "the potential is there for [respondent] to control the entire Nation's gasoline market." We take no position on the validity or significance of those patents. We note, however, that Congress could require a patentholder in that situation to license its patent at just and reasonable rates. See *FCC* v. *Florida Power Co.*, 480 U.S. 245, 253-254 (1987).

that *could be burned.*" *Id.* at 41a. But both courts found "extensive support," *id.* at 11a, for a narrower construction in the patent application's description of the automobile emissions problem addressed by their invention, its comparisons of the claimed gasolines to "typical gasoline fuel," its description of the benefits to be obtained from use of the claimed gasolines, and its use of ordinary passenger automobiles in testing the claimed fuel. See *id.* at 11a-12a, 36a-39a.

Petitioners argue (Pet. 19-26) that the patent may not fairly be read to include the limitation to standard automotive fuels adopted by the court of appeals. They argue that the key phrase in the claims describes a fuel "suitable for combustion" in an automobile, and that the clear meaning of that phrase would include aviation and racing fuels that can be—and sometimes are—used in a standard automobile engine. Although the court of appeals disagreed with petitioners on that point, the court adopted the key legal principles relied upon by petitioners. For example, petitioners rely (Pet. i) on the principles that a court may not "include elements not mentioned in the claim in order to limit such claim and avoid a defence of anticipation," *McCarty* v. *Lehigh Valley R.R.*, 160 U.S. 110, 116 (1895), and that "[i]t is not invention to perceive that the product which others had discovered" could be used in ways not previously perceived, *General Elec. Co.* v. *Jewel Incandescent Lamp Co.*, 326 U.S. 242, 249 (1945). There was, however, no disagreement about those principles here. The court of appeals agreed that claims could not be altered by construction, stating that the "constuction of claims is simply a way of elaborating the normally terse claim language[] in order to understand and explain, but not to change, the scope of the claims." Pet. App. 10a (quoting *Scripps Clinic & Research Found.* v. *Genentech,*

Inc., 927 F.2d 1565, 1580 (Fed. Cir. 1991)). Moreover, the court expressly held that "[t]he scope of these composition claims cannot * * * embrace only certain uses of that composition," thus recognizing that merely finding an obvious new use for an existing product is not an invention. Pet. App. 10a.[7]

Given the agreement on the general nature of the rules governing the construction of patent claims, this case simply presents the question whether the courts below erred in construing the particular terms of the '393 patent. In our view, reasonable minds could differ on that question. But it is difficult to imagine a case in which the construction of the claims of a particular patent would present an issue sufficiently important to warrant this Court's attention. In any event, as we explained above, although the '393 patent may turn out to be a very important one, its precise effect on the gasoline market remains uncertain, and it is not of sufficient general importance to warrant this Court's review.

3. Petitioners argue (Pet. 15) that respondent engaged in "gaming of the regulatory * * * process" by filing a broad patent application, participating in the CARB regulatory process without disclosing its patent application, and then modifying the claims in the application to more closely resemble the requirements that CARB adopted. We share the concern expressed by petitioners and amici that a party could attempt to employ the patent laws to take unfair advantage of an

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[7] Petitioners assert (Pet. 25) that the court of appeals "narrow[ed] [the] patent claims to avoid invalidity." The court's construction of the patent, however, was not based on a desire "to avoid invalidity," but on the court's perception that its construction was "confirm[ed]" by the claim language and found "extensive support in the specification." Pet. App. 10a-11a.

open regulatory process. The federal and state governments have come increasingly to explore possibilities for developing rules through open and voluntary consensual processes involving all affected parties. Members of a regulated industry may well be reluctant to bring their own technical knowledge and policy views to such a public forum if they fear that their competitors will use the shared information about technologies and regulatory strategies to craft overly broad patents. Thus, the threats posed by "gaming" the regulatory process could operate as a serious disincentive to industries to participate in the kinds of alternative rulemaking strategies that are clearly in the public interest.

Although we share the concerns of petitioners and amici, we do not think that the narrow legal questions presented in the petition for certiorari present an appropriate vehicle to address those concerns. Petitioners rely solely on the "written description" requirement in 35 U.S.C. 112 to address what they view to have been respondent's "gaming." But the "written description" requirement does not vary depending on whether a governmental entity ultimately determines that practicing the patented invention is a useful (or even the only) way to satisfy a legal requirement. The fact that an invention is particularly useful in satisfying a government clean air or other standard certainly does not lessen the value of the invention to society or the patent protection that it should be afforded. Thus, if respondent "had possession" of the claims of the '393 patent as of the December 1990 filing date of the patent application, as the courts below held, the subsequent adoption of regulations would not have any effect on the

sufficiency of the written description for patentability purposes.[8]

That is not to say that there are no mechanisms available to address "gaming" of a regulatory system. It has long been accepted that misuse of a patent or inequitable conduct before the Patent Office can render a patent unenforceable. See, *e.g.*, *Zenith Radio Corp.* v. *Hazeltine Research, Inc.*, 395 U.S. 100, 135-141 (1969) (patent misuse); *Precision Instrument Mfg. Co.* v. *Automotive Maint. Mach. Co.*, 324 U.S. 806 (1945) (inequitable conduct); see also Pet. App. 22a-23a (rejecting petitioners' argument that respondent engaged in "inequitable conduct"). Petitioners, however, do not present a claim of patent misuse, which in any event typically involves the exploitation of patent protection by the patentee. Petitioners do not argue that the "patent misuse" doctrine should be expanded to include the conduct they allege in this case, nor do they outline the contours of liability under such a doctrine or the

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[8] The fact that respondent's disclosure was broader than the 41 claims now at issue is similarly of no moment if the 41 allowed claims are sufficiently described in the specification. See *Wertheim*, 541 F.2d at 263 ("That what appellants claim as patentable to them is *less* than what they describe as their invention is not conclusive if their specification also reasonably describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable."); *In re Saunders*, 444 F.2d 599, 607 (C.C.P.A. 1971) (recognizing right of applicant initially claiming broad genus "to retreat to an otherwise patentable species" by narrowing claims during prosecution). Therefore, even if respondent's claims were amended to "resemble" the CARB regulations, as long as the amended claims are sufficiently described in the originally filed specification, the reason for amendment is not a fact that will affect the patentability analysis under 35 U.S.C. 112.

legal consequences that would flow from a finding that it occurred. Nor do petitioners argue before this Court that fraud was committed on the Patent Office itself.

Another potentially relevant means to challenge a patent would be the requirement of 35 U.S.C. 102(f) that a patent is invalid if the patentee "did not himself invent the subject matter sought to be patented." The district court, however, rejected petitioners' derivation argument under Section 102(f) in this case, finding that "[n]o competent evidence was introduced in support of th[e] argument" that respondent "had copied the invention from CARB." *Union Oil Co.* v. *Atlantic Richfield Co.*, 34 F. Supp. 2d 1208, 1224 (C.D. Cal. 1998). Indeed, the district court sanctioned petitioners in part for their failure to make good on their commitment to the court to produce evidence on that point. *Ibid.* Petitioners did not preserve that issue on appeal and have not presented it in their petition for certiorari.

Similarly, other government agencies, such as the Federal Trade Commission, may impose non-patent remedies against parties who make affirmative misrepresentations to a public or private regulatory body involved in setting industry standards. See *In re Dell Computer Corp.*, 121 F.T.C. 616 (1996) (sanctioning firm for making an affirmative misrepresentation to a nonprofit association that it had no intellectual property that would be affected by an upcoming industry standard, while concealing its issued patent whose claims covered portions of the industry standard). Those remedies too are not at issue in this case.[9]

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[9] Petitioners rely (Pet. 14) on *SmithKline Beecham Consumer Healthcare, L.P.* v. *Watson Pharm., Inc.*, 211 F.3d 21 (2d Cir.), cert. denied, 121 S. Ct. 173 (2000), for the proposition that a copyright that covers a matter required by regulation—labels on medicine—supports their contention that the issuance of regulations by

What is at issue in this case are essentially fact-specific questions concerning the application of settled legal standards in patent law to the particular terms of what may be a very significant patent. This case does not present a suitable vehicle for this Court to address the larger problems surrounding the intersection of the patent and regulatory processes that petitioners and amici seek to raise.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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CARB has a bearing upon the validity of the '393 patent. *SmithKline*, however, concerned whether a federal statute concerning generic drugs (21 U.S.C. 355(j) (1988)) had the effect of creating an exception in the copyright law for labels on generic drugs. This case involves the patent laws, not the copyright laws, and there is no issue in this case concerning the possible effect of another federal statute on the patent protection that should be afforded respondent.

APPENDIX

The following testimony of Dr. Peter J. Jessup is reprinted from C.A. App. 562-563:

Q: BY MR. KEKER:

After the CARB regulations, and that is the California Air Resources Board regulations, came out in November of 1991, were the claims that still remained in your patent changed completely to copy the RVP, the T50 and the olefin numbers of the Air Resources Board regulations?

MR. CIRESI: Objection, your Honor.

THE COURT: That was the same question.

MR. KEKER: Yes, ma'am.

THE COURT: All right. Overruled.

THE WITNESS: Okay. Some of our claims were narrowed. Some of our claims were broader than the CARB regulations. Some of them were narrowed at various times to resemble the CARB regulations, but they were never copied from the CARB regulations.

That's rather a strange thing to say.

Q: Were the numbers that you used in the claims for RVP and T50 and olefins taken from the numbers that the Air Resources Board used in their regulations?

A: No, we never did that.